

Application No. 10/067,
Amendment "B" dated June 28, 2005
Reply to Office Action mailed May 25, 2005

REMARKS

The final Office Action, mailed May 25, 2005, considered claims 1-38 and 40-42. Claims 1-7, 10-29 and 32-28 and 40-42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al. (U.S. Patent No. 5,651,107) in view of Bertram et al. (U.S. Patent No. 5,652,630). Claims 8, 9, 30 and 31 were rejected under 35 U.S. C. 103(a) as being unpatentable over Frank et al. (U.S. Patent No. 5,651,107) and Bertram (U.S. Patent No. 5,652,630) in view of Yoneda (U.S. Patent No. 6,587,118).¹

By this paper, claims 1, 17, 23 and 40 have been amended, such that claims 1-38 and 40-42 remain pending, of which claims 1, 12, 17, 22, 23 and 34 are the only independent claims that remain at issue.

The claims are generally directed to three basic embodiments for displaying and controlling the transparency of a user interface and a video stream.

Claims 1 and 23 are directed to a first embodiment, wherein claim 1 recites a method and claim 23 recites a corresponding computer program product for implementing the method of claim 1.

As recited in this first embodiment, screen data is generated and displayed from a mixture of a user interface and a video stream. User input from a remote control of a set-top box is also received that controls the level of transparency of the user interface. In response to the user input, the level of transparency of the user interface is adjusted. As further clarified, the system performing the method also includes means for adjusting the level of transparency of the user interface independently from or simultaneously with the level of transparency of the video².

The primary reference Frank discloses how the transparency of different windows can be adjusted. However, the Examiner has not indicated whether Frank is being cited for the

¹ Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last response, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

² Support for this clarification is found throughout the specification, including, but not limited to the disclosure found in paragraphs 36 and 37 of the specification. Some of the dependent claims, which were originally filed, also support this embodiment (claims 4 and 7).

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proposition of simultaneous or independent control for adjusting the different transparency levels of the different window. Either way, Frank clearly fails to disclose or suggest both simultaneous and independent control for adjusting the different transparency levels. In fact, in this regard, the Examiner has failed to fully address the limitations of original claims 4 and 7, which claim alternative embodiments for adjusting the transparency levels either simultaneously (claim 4) or independently (claim 7).

For at least these reasons, Applicants respectfully submit that the embodiment recited in claims 1 and 23 is not made obvious by the art of record.

The next embodiment is recited in claims 12 and 34, wherein claim 12 recites a method and claim 34 recites a corresponding computer program product for implementing the method of claim 12.

This second independent embodiment is similar to the first, except that the user input is clarified as comprising a selection of one or more volume control buttons on a remote control device of a set-top box.

The last independently claimed embodiment is found in claims 17 and 22, wherein claim 17 recites a method and claim 22 recites a corresponding computer program product for implementing the method of claim 17.

In this embodiment, a global level of transparency is associated with the user interface that controls the transparency of all of the plurality of different items displayed with the user interface. As further clarified, the different items of the user interface can also have independent levels of transparency that can be individually adjusted independently of the global level of transparency. For example, as recited, the method includes selecting one of the plurality of different items included in the user interface and adjusting the level of transparency of the selected item independently of the global level of transparency, such that when the level of transparency of the selected item is adjusted, the global level of transparency remains unchanged³.

Initially, Applicants respectfully submit that the cited art, individually and in combination, fails to make obvious the claimed invention. In order to establish a *prima facie*

³ Support for the amendments to this claim are found throughout the specification, including, but not limited to the disclosure found in paragraphs 9, 34, 44 and 51.

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case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added).

In the present application, the cited art fails to teach or suggest all of the claim limitations. For example, with regard to the embodiment recited in claims 1 and 23, the cited art fails, among other things to disclose or suggest a method that is implemented in a system that includes both (a) means for adjusting the level of transparency of the user interface and a level of transparency of the video simultaneously, such that adjusting the level of transparency of the user interface necessarily adjusts the level of the video, and (b) means for adjusting the level of transparency of the user interface independently of the level of transparency of the video and such that adjusting the level of transparency does not affect the level of transparency of the video, and such that the act of adjusting the level of transparency of the user interface selectively includes at least one of adjusting the level of transparency of the user interface independently or simultaneously with the level of transparency of the video. This is also true when considering that dependent claim 4 requires simultaneously adjusting the level of transparency of the user interface and the video stream, and wherein dependent claim 7 requires independently adjusting of the level of transparency of the user interface.

With regard to the second independently claimed embodiment, recited in claims 12 and 34, the cited art also fails, alone or in combination, to disclose or suggest, among other things, a method wherein a level of transparency of the user interface is adjusted in response to user input comprising selection of one or more volume control buttons on a remote control (see also claims 40, 42), or a method that includes programming the remote control so that the selection of the one or more volume control buttons in combination with selection of at least one other remote control button indicates to the set-top box that the transparency should be changed.

In this regard, the Examiner has acknowledged Frank, the primary reference, fails to disclose the system comprises a set-top box and that the user input for adjusting the transparency includes input comprising selection of a remote control. To compensate for this failure, the Examiner suggests that Bertram teaches a video display which may be associated with a set top device and a remote control. The Examiner then conclusively states

it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Bertram, using the overlay displaying of the user interface and the video stream in a set-top box, to be used in Frank's device so as motivated by Bertram, to have a remote control with access

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to the resources of the system with which it is related, and wherein the navigation among functions available and resource allocation is accomplished by display of on-screen images which overlay or modify the images derived from the video/audio streams entering the television space, and which is accomplished by minimal buttons. (col. 2, lines 19-25).

This line of reasoning by the Examiner, however, falls well short of showing how each and every claim element is disclosed by the cited art or why there would be a motivation for combining the art to practice the claimed invention, even if the art did teach all of the recited claim elements, which it doesn't.

In particular, the Examiner has failed to show or suggest how the level of transparency of a user interface or video content is adjusted according to input comprising selection of one or more remote control buttons, such as volume control buttons, particularly when considering that in some embodiments the input requires selection of a volume control button in combination with another button (claim 41), or wherein the volume control button is a mute button (claim 42), or wherein prior to receiving this input, the method requires programming of the remote control (claim 40).

Instead of showing where this is taught or suggested in the prior art, the examiner appears to be taking official notice that it would simply be possible for someone to modify the art to practice the invention by stating

it would have been obvious to a person of ordinary skill in the art at the time the invention was made to realize that changing the transparency by changing the volume would be easy using such combination because changing the volume requires the volume key to be displayed on the display in Bertram's device, and that would prompt a change in transparency in Frank's device. This is obvious because it [is] merely a designer choice that can be done using the teaching of Frank.

This statement, however, does not make any sense. In particular, there has been no nexus or motivation provided for using a remote control, such as that of Bertram to control transparency of displayed objects, such as those shown in Frank. Although it is true that Bertram provides a system that uses minimal buttons to accomplish a desired action. There is no suggestion that the use of a volume control button would be used to modify transparency. In other words, why would it be obvious to use a volume control button to control transparency, or why would one of ordinary skill in the art be motivated to make a volume control button control

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transparency, particularly when Frank already discloses another means for controlling transparency.

Furthermore, in specific regard to the Examiner's rejection, Applicants respectfully point out that the Examiner's rejection requires that the volume be changed. (Page 7, last paragraph of the last Office Action) This, however, is not what is presently claimed. Instead, it is input from the volume control that can be programmed to adjust transparency, not an actual change in the volume.

Additionally, as stated above, it appears that in rejecting this claimed embodiment, the Examiner is attempting to merely suggest that it would be possible to modify the remote disclosed in Bertram to perform the operation of the present invention. However, in this regard, Applicants remind the Examiner that in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all claim limitations." MPEP § 2143. Furthermore, the "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS." MPEP § 2143.01. This is true even all of the elements are taught by the cited art, which they aren't in this case.

In fact, "A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP 2143.01

Furthermore, Applicants also point out that with regard to any art that might be combined by the Examiner in any future rejection of this case, that the motivation for making such a combination must come from the references themselves, not the Applicant's own application, otherwise such a combination represents impermissible hindsight. In particular, as stated by the MPEP § 2143, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure."¹

The Examiner has attempted to provide motivation for combining the references, by suggesting Bertram wants to utilize minimal buttons. This, however, has nothing to do with

¹ MPEP 2143. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). (emphasis added)

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transparency control. This also does not provide an objective reason or for motivation for using the volume control buttons. This is particularly true when considering that Frank already provides a detailed and intricate system utilizing controllable UI sliders for adjusting transparency levels of displayed windows.

Accordingly, for at least the foregoing reasons, the cited art fails to make obvious the claimed invention, as recited in claims 12 and 34, for example, that includes the use of user input comprising the selection of volume control buttons to adjust transparency levels, in combination with the other recited claim limitations.

Now, with regard to the last independently claimed embodiment, recited in claims 17 and 22, the cited art also fails, alone or in combination to disclose or suggest a method that includes, among other things, a user interface having a plurality of selectable items and that have transparency levels that can be adjusted independently of a global transparency level associated with the user interface.

In this regard, Applicants respectfully point out that the Examiner has failed to address each of the limitations that were present in the previously recited claims, thereby failing to establish a *prima facie* case of obviousness. In particular, the previous rejection failed to consider a global transparency level of a user interface, which is different than a transparency level of a selected item of the user interface. Nevertheless, the claim has been amended, although not necessarily, to further clarify and point out this distinction.

The new amendments clarify that adjusting the global level of transparency simultaneously adjusts transparency of each of the different selectable items of the user interface. One of the selectable items of the user interface is selected in the independent claim and a plurality items are selected according to the embodiment recited in dependent claim 18. Either way, the selected one or more (claim 18) items have their level of transparency level(s) adjusted, and in such a way that the global level of transparency remains unchanged. The cited disclosure of the prior art fails to disclose or suggest such a claim embodiment. In fact, it has not even been purported to disclose or suggest this. Accordingly, for at least these reasons, Applicants submit that this last independent claim embodiment is also allowable over the art of record.

Although the foregoing remarks have focused primarily on the independent claims, it will be appreciated that, for at least the foregoing reasons, all of the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need

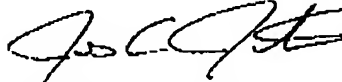
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not be addressed individually. However, in this regard, it should be appreciated that Applicants do not necessarily acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions at any appropriate time in the future, should the need arise, including any official notice.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 28 day of June, 2005.

Respectfully submitted,



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